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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/750,451
Filing Date: December 31, 2003
Appellant(s): KONINGSTEIN ET AL.

Leonard P. Linardakis
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 1/10/2011 appealing from the Office action mailed 6/9/2010.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

2003/0055816	PAINE	3-2003
2002/0052894	BOURDONCLE	5-2002
2001/0052000	GIACALONE	12-2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 6-10, 14, 19-23, 27, 30, 32-36, 42, 47-51, 55, 60-64, 69, 71, 73-77, 81-84, and 86-88 are rejected under 35 U.S.C. 102(e) as being anticipated by Paine (U.S. Pub. No. 2003/0055816). Paine shows a method and apparatus for recommending search terms to an advertiser that includes all of the limitations recited in the above claims.

Regarding claims 1, 14, 27, 42, 55, 68, 81-84, and 86-88, Paine teaches accepting a category (initial search term entered by advertiser), looking up one or more keywords based on a previously stored association of a plurality of keywords and categories (related search terms, thesaurus, and string matching algorithm), displaying the keywords to the advertiser and receiving advertiser input in response to the suggestion, determining whether to store at least some of the keywords as ad targeting keywords based on the advertiser input (add bidded search term) (Paragraphs 0073, 0086, 0107, and 0111), and serving an advertisement for presentation to a user using the ad targeting keywords (Paragraph 0040). Paine further discloses accepting ad information, and determining a category from the ad information (Abstract, Sentences 1-3).

Regarding claims 6, 19, 32, 47, 60, and 73, Paine teaches the performing of qualification testing of the determined one or more keywords to determine if a keyword is qualified or unqualified for use as an ad targeting keyword and the providing of those qualified keywords as ad targeting keywords (Paragraphs 0115-0116).

Regarding claims 7-10, 20-23, 33-36, 48-51, 61-64, and 74-77, Paine teaches the tracking of the performance of all ads served using an ad targeting keyword.

Paine's tracking is performed in general as well as across specific categories, including the accepted category and advertiser search listing (Paragraphs 0087-0088).

Regarding claims 30 and 71, Paine teaches advertisements as having ad creative information for rendering the ad (different descriptions) and a landing webpage linked from the advertisement (Figure 7). Paine further teaches using information from the advertiser webpage to determine ad creative information (Abstract).

Claims 2, 11, 15, 24, 28, 29, 37, 43, 52, 56, 65, 69, 70, and 78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paine (U.S. Pub. No. 2003/0055816).

Regarding claims 2, 15, 28, 43, 56, and 69, Paine's invention doesn't appear to specify a tool that keeps track of negative ad targeting keywords. Paine does teach that it is well known to have a tool to keep track of two lists, a list of good words for an advertiser's site and a list of negative keywords having no relation to the advertisers site or content (Paragraph 0008). It would have been obvious to one having ordinary skill in the art at the time the invention was made to include negative keywords into the system of Paine. This would allow more accuracy in relation to relevant keywords.

Regarding claims 29 and 70, Paine teaches advertisements as having ad creative information for rendering the ad (different descriptions) and a landing webpage linked from the advertisement (Figure 7). Paine further teaches using information from the advertiser webpage to determine ad creative information (Abstract). Paine does not appear to specify using information from the advertisement to determine a category. However, since Paine shows the advertisements as being html-based text ads (Figure

7) and Paine discloses determining ads based on webpages (webpages being based on html) (Abstract), the technology to read advertisement content to determine categories is present in Paine. It would have been obvious to one having ordinary skill in the art at the time the invention was made to determine category information from the advertisement itself to better target the ad and determine more relevant keywords.

Regarding claims 11, 24, 37, 52, 65, and 78, Paine teaches a system for recommending ad targeting keywords for ads displayed on a search site. Paine doesn't appear to go into detail about the type of space that will be used for the ad on the search site. While it may not be inherent, common sense dictates that when a new advertisement is added to a search page, it should be added to an ad spot that would otherwise be unused, or the 2 advertisements would overlap and some data would be obstructed from view. It would have been obvious to one having ordinary skill in the art at the time the invention was made to specify an advertisement as being served on a portion of the webpage that would otherwise be unused. This would keep the operator of the search site from overlapping other information with an advertisement.

Claims 5, 18, 31, 46, 59, and 72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paine (U.S. Pub. No. 2003/0055816) in view of Bourdoncle (U.S. Pub No. 2002/0052894).

Regarding claims 5, 18, 31, 46, 59, and 72, Paine teaches recommending keywords based on numerous methods including a thesaurus database. While it could be argued that a thesaurus database would have to implement an index using a lookup

key according to the well-known functionality of thesauruses (looking up words using other words as lookup keys), it could also be argued that such a teaching does not appear to be specified by Paine. However, Bourdoncle teaches an example of an index in which one type of information is used to locate another type of information (Claims 28 and 30). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use an index (much like one implemented in a common thesaurus, and like the one taught by Bourdoncle) to correlate the categories and keywords of Paine. Such a method will allow for speedy lookup times.

Claims 12, 13, 25, 26, 38, 39, 53, 54, 66, 67, 79, and 80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paine (U.S. Pub. No. 2003/0055816) in view of Giacalone (U.S. Pub No. 2001/0052000).

Regarding claims 12, 13, 25, 26, 38, 39, 53, 54, 66, 67, 79, and 80, Paine does not appear to specify storing keywords in a specific order to present to an advertiser based on inventory criteria. However, attempting to market certain items ahead of other items because that first item has a larger inventory that needs to be sold is an old and well-known concept. While Paine teaches selling an inventory of ad spots according to keyword (Paragraph 0075), Giacalone teaches a system and method in which advertisements for clothing that have the highest inventory are shown more, and when another clothing item attains the highest inventory, that item will then be advertised above the others (Paragraph 0027). It would have been obvious to one having ordinary skill in the art at the time the invention was made to store, present, and advertise

keywords to advertisers based on the number of ad slots in inventory for each keyword. Giacalone discloses that by advertising high-inventory items, more sales will occur for those items (Paragraph 0027).

(10) Response to Argument

Response to Appellant's argument of Examiner's interpretation of "category" and "keyword":

Examiner brings forth the point that figure 9 of Paine uses "automobile" as an example of a search term. On page 21 of the Appeal Brief, Appellant refers to "automobile" as an example of a category. Appellant currently argues "the fact that a particular term might be used as a label representing a category does not mean that the same term, when used as a search term, represents a category". The category of Appellant's invention is merely a word used to look up other words. The search term of Paine is merely a word used to look up other words. A category may simply be defined as a term in which to describe other data which may fall under the umbrella of the original term. Appellant states that "the ordinary meaning of category is a defined class in a classification system". These definitions also apply to the search terms of Paine. Much like the words "category" and "keyword", "trash" and "garbage" are two words with the same meaning. Under the Appellants argument, "trash" could not be used in place of the word "garbage", because although they mean the same thing, they are different words. Just because "category" is a different word than "keyword", does not mean these two terms do not have the same meaning in the context of Appellant's invention.

They are both merely words used to look up other words. By linking a keyword to other keywords such as automobile being linked to other terms, those other terms fall under the word automobile in the "classification system" of Paine.

More importantly, Appellant also never specifically defines "category" in the specification. In figure 3 of Appellant's drawings, a category may be used to look up a keyword while a keyword may also be used to look up a category. In one instance, the "keyword" word is the category used to look up the "category" word. Apparently, Appellant's specification uses "category" and "keyword" interchangeably to perform the same functions, yet Appellant argues they are not the same. Examiner feels that this is simply an argument over semantics, and that category and keyword are equivalent in the context of the current application and the prior art. Categories in the context of Appellant's invention are represented as words. Keywords are words as well. There is virtually no difference between Applicant's claimed use of the word "category" and Paine's use of keywords to look up other keywords.

On page 21 of the Appeal Brief, Appellant states that "the website Amazon.com includes product categories including Books, Music, DVD, VHS". However, such "categories" are also examples of keywords, and it is unclear as to how the category "Music" would not be a keyword having other keywords such as "Justin Beiber" or "Metallica" associated with it. As stated above, Examiner contends that category and keyword are synonymous with regards to Appellant's claimed invention, and the Paine reference is perfectly on point.

Response to Appellant's argument of the 102(e) rejection of claims 1, 14, 27, 42, 55, 68, and 81-84:

Appellant argues that neither spidering, nor collaborative filtering, nor their combination, teach an act of or means for determining one or more keywords using at least one category. Appellant state's that "spidering may provide recommended search terms which a new advertiser may accept or reject" and "collaborative filtering may be used to provide an updated list of search terms which may be accepted or rejected" (both of these concepts are taught by Paine). Examiner considers a search term to be a category for the reasons stated above. Based on this information, Paine reads on the above claims. Appellant further argues "this collaborative filtering process to get terms (alleged to be keywords) used by other advertisers from existing terms (alleged to be categories) is not using a category to lookup one or more keywords". Once again, Examiner would like to point out that the term "looking up" is a broad term. Getting terms used by other advertisers from existing terms is a step of looking up one set of terms based on another.

Further, Examiner would like to point out that the rejection lists ways of looking up keywords using other keywords, including a thesaurus as taught by Paine. A thesaurus is directly on point with Applicant's claimed finding of keywords based on categories, as a thesaurus is broken down according to a hierarchy system in which a second word falls under the umbrella of a first word, and a third word falls under the umbrella of a second word, and so on and so forth.

Response to Appellant's argument of the 102(e) rejection of claims 86-88:

Appellant argues "the use of collaborative filtering in the Paine Publication to get terms (alleged to be keywords) used by other advertisers from existing terms (alleged to be categories) does not specifically associate the existing terms with the terms used by other advertisers". If a program is able to get one set of terms from another set of terms, those two sets of terms have to be inherently "associated". If the terms were not associated whatsoever, then no terms would be returned. Once again, Examiner relies on the fact that "associated" is a very broad term. One term that is listed in a thesaurus as a synonym of another term is an example of an association.

Response to Appellant's argument of the 102(e) rejection of claims 6, 19, 32, 47, 60, and 73:

Appellant argues "the Examiner's interpretation of "qualification testing" is inconsistent with how one skilled in the art would interpret this term in light of the specification". However, Appellant does not explicitly define the term "qualification testing" in the specification. Rather, on page 24 of the Appeal Brief, Appellant states "the specification of the present application provides an example of such qualification testing" and cites the specification as stating "Figure 8 is a flow diagram of an exemplary method 800 that may be used". These are examples of possible qualification testing, but the specification does not concretely define such testing. The specification does not limit the invention to exclude the type of qualification testing Examiner has found within Paine. Since the Examiner prides himself as one who is skilled in the art,

Examiner feels that the interpretation of qualification testing is indeed consistent and is appropriate due to the broad nature of the term "qualification testing".

Response to Appellant's argument of the 102(e) rejection of claims 7-10, 20-23, 33-36, 48-51, 61-64, and 74-77:

Appellant argues "merely tracking performance does not teach using such performance for purposes of performing qualification testing of keywords". Paine teaches tracking performance. The reasons for the tracking (for purposes of performing qualification testing) are intended use and is given little patentable weight. Paine still teaches both qualification testing and performance tracking.

Response to Appellant's argument of the 102(e) rejection of claims 30 and 71:

Appellant argues "although an advertiser website might be linked to an ad, these claims recite that the ad includes ad creative information for rendering the ad and an address of a landing webpage linked from the ad". The claims recite "ad information". "Ad information" is a broad term that could be interpreted any number of ways. Paine does indeed teach the claimed advertisement content at Figure 7.

Response to Appellant's argument of the 103(a) rejection of claims 2, 15, 28, 43, 56, and 69:

Appellant argues that Paine teaches "positive and negative scores assigned to keywords for determining whether a new advertiser is similar to an existing advertiser."

Paragraph 0008 of Paine recites: "This tool keeps track of two lists; an accept list of good words for an advertiser's site, and a reject list of bad words or words that have no relation to the advertiser's site or it's content". Examiner feels that this is sufficient material to read over the above claims and the rejection still stands.

Response to Appellant's argument of the 103(a) rejection of claims 11, 24, 37, 52, 65, and 78:

Examiner contends that a web page developer would not put 2 advertisements on top of one another in the interest of both items being viewable. Appellant argues "the Examiner's position ignores the fact, understood by those skilled in the art, that an advertisement can displace another advertisement from an ad spot". Examiner agrees that this is one plausible interpretation of the broad claim language. However, another plausible interpretation suggests that if an advertisement is to be placed on a webpage, it would not be placed in a spot that is currently used by another advertisement. This would block the view of the advertisement that was originally in that position. This interpretation meets the broad claim language, and is indeed an interpretation that would be used by one skilled in the art.

Response to Appellant's argument of the 103(a) rejection of claims 5, 18, 31, 46, 59, and 72:

As explained above, the rejections of the independent claims appear to be proper, and therefore these rejections are also proper.

Response to Appellant's argument of the 103(a) rejection of claims 12, 13, 25, 26, 38, 39, 53, 54, 66, 67, 79, and 80:

Appellant argues "scheduling an advertisement to appear more frequently after specifically querying the database to determine the inventory of the product being advertised does not teach storing one or more keywords in an order determined using unused inventory information about available ad spots". However, Examiner has explained the position on this in the rejection above. Ad spots are the item being marketed for sale, and when more ad spots are available for a specific keyword, that keyword would be marketed before other keywords. The Giacalone reference teaches that this concept of favorable advertising for high inventory items (such as high inventory available ad spots) is an old and well known concept. Such a concept can be applied for any type of product that needs to be advertised, including keywords for available ad spots. All of this has been laid out in the rejection above, and this rejection seems right on point with the claimed limitations.

KSR forecloses the argument that a specific teaching is required for a finding of obviousness (citing *KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396). See Board decision *Ex parte Smith*, --USPQ2d--, slip op. at 20, (Bd. Pat. App. & Interf. June 25, 2007).

Further, It must be presumed that the artisan knows something about the art apart from what the references disclose. In re Jacoby, 309 F.2d 513, 135 USPQ 317 (CCPA 1962). The problem cannot be approached on the basis that artisans would only know what they read in references; such artisans must be presumed to know

something about the art apart from what the references disclose. In re Jacoby. Also, the conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint of suggestion a particular reference. In re Bozek, 416 F.2d 1385, USPQ 545 (CCPA 1969). And, every reference relies to some extent on knowledge or persons skilled in the art to complement that which is disclosed therein. In re Bode, 550 F.2d 656, USPQ 12 (CCPA 1977).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Michael Bekerman /Michael Bekerman/
Primary Examiner, Art Unit 3622

Conferees:

John Van Bramer
/J. V./
Primary Examiner, Art Unit 3622

Eric Stamber/E. W. S./
Supervisory Patent Examiner, Art Unit 3622